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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/152,593	09/14/1998	HIROSHI HASEGAWA	BA-22624	9416

178 7590 10/16/2003

BUCKNAM AND ARCHER
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

EXAMINER

DIAMOND, ALAN D

ART UNIT PAPER NUMBER

1753

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/152,593

Applicant(s)

HASEGAWA ET AL.

Examiner

Alan Diamond

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 07/634,054.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Comments***

1. The instant claims are now fully supported by each of parent applications 08/539,001, 08/193,281, 08/019,177, and 07/634,054, as well as the certified English translation of Japanese foreign priority document 1-341244, which has a filing date of December 28, 1989. Accordingly, the instant claims have a foreign priority date of December 28, 1989. Upon reconsideration, the Examiner does not deem the recitation that "the number of straight-chain alkyl groups is present in a concentration of not more than 60% of the total number of alkyl groups" to be a required limitation for support in the instant parent applications and said certified English translation of Japanese foreign priority document 1-341244. There is nothing in said parent applications and certified English translation that would necessitate that said recitation be present. Accordingly, the art rejections based on Ishida et al (US 5,447,647), Kamakura et al (US 5,620,950), EP 448402, and Zehler et al, (US 5,021,179) are now moot since said December 28, 1989 foreign priority date antedates these references.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,410,492.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the ester in the claims of said patent is an ester obtained from pentaerythritol and a carboxylic acid mixture comprising n-pentanoic acid in an amount of 20 to 50% by mass, n-heptanoic acid in an amount of 30 to 50% by mass and 3,5,5-trimethylhexanoic acid in an amount of 5 to 60% by mass. This ester encompasses the instant ester, particularly in view of the fact that the esters prepared in said patent's examples at cols. 7 and 8 are tetraesters. The claimed ester is used with a chlorine-free fluorocarbon refrigerant (claim 9 of said patent), and contains the instantly claimed additives (claims 5 to 7 of said patent). Although the claims of said patent use "comprising" language, whereas the instant claims use "consists of" language, there are no additional required components in the claims of said patent that would be excluded by said "consists of" language. Accordingly, the instant claims are rendered obvious by the claims of said patent.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Application Publication 2002/0193262, and U.S. Patents 6,551,523 and 6,551,524 are hereby made of record.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is 703-308-0840. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 703-308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Examiner Diamond will move to the new USPTO facility in Alexandria, VA in December 2003. The Examiner's new phone number after the move will be 571-272-1338.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'Alan Diamond', with a stylized flourish at the end.

Alan Diamond
Primary Examiner
Art Unit 1753

Alan Diamond
October 10, 2003